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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,676	10/10/2001	Toshihiro Morita	275782US6	7507

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EXAMINER
LU, CHARLES EDWARD

ART UNIT	PAPER NUMBER
2161	

NOTIFICATION DATE	DELIVERY MODE
04/20/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	**Applicant(s)**
Office Action Summary	09/974,676	MORITA ET AL.
	Examiner	**Art Unit**	
	CHARLES E. LU	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 December 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1. This Action is in response to the Request for Continued Examination dated
12/23/2008. Claims 2-19 are pending and rejected.

Response to Amendments/Response to Arguments

2. Applicant's remarks and arguments were fully considered.

3. Claim 17 was amended for 35 USC 101. However, the amendment
necessitates a new grounds of rejection under 35 USC 101.

4. Applicant's remarks regarding the prior art-based rejection were fully
considered. Applicant argues the claims as amended. The previous grounds of prior
art-based rejection are withdrawn. The new grounds of rejection presented below are
necessitated by amendment, and the arguments are moot in view of the new grounds of
rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

**5. Claim 17 is rejected under 35 USC 101 because the claimed invention is
directed to non-statutory subject matter.**

As to claim 17, the claimed "computer program product having instructions" is
understood to be software per se. Although the claim recites "when executed by a
processor," the processor is optional, and furthermore, is not understood as being part

of a computer program. A computer program is software per se, which is nonstatutory.

Applicant may consider amending the claims to recite "a computer readable storage

medium with instructions recorded thereon, that when executed by a processor,

performs the claimed steps" or other similar language. Functional descriptive material,

when recorded on some computer readable medium, is statutory is most cases. MPEP

2106. However, such amendments must be supported by the specification.

The prior art-based rejection is applied in anticipation of Applicant overcoming

the 101 rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2-19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Guck (U.S. Patent 5,911,776), hereinafter "Guck," in view of Putz et al. (U.S.

Patent 5,210,824), hereinafter "Putz," and further in view of Astle (U.S. Patent

5557330), hereinafter "Astle."

As to claim 9, Guck teaches the following claimed subject matter:

A record controlling step for controlling a record in which first data identified a

predetermined content, second data identifies a first file for storing the predetermined

content in a first format, and third data identifying a second file for storing the

predetermined content in a second format, the first, second, and third data all corresponding to the predetermined content (col. 16, ll. 1-67, col. 17, l. 60 – col. 18, l. 14).

A specifying step for specifying the predetermined content on the basis of the first data (see above);

A selecting step for selecting either the first or second file in association with the predetermined content specified in the specifying step (see above);

A manipulating step for manipulating the first or second file on the basis of the second data or third data in association with either the first or second file, whichever has been selected (see above).

Guck teaches second and third data generally, but does not expressly teach wherein the second data identifies a first file of the content stored in a first format, and wherein the third data identifies a second file of the content stored in a second format.

However, Guck teaches or suggests eventually containing stored, "actual content" after the file conversion routine is used (e.g., see above, fig. 2, 4, etc). Thus, Guck may have a first and second file of stored content stored in respective different formats. Furthermore, Putz teaches or suggests, in file conversion, creating a converted file with stored content in the respective format, and then caching the converted file so that in subsequent requests, the conversion need not be performed again, and the converted file can be presented to the user directly (e.g., col. 17, ll. 33-51, col. 5, ll. 25-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Guck, such that a converted file is cached, and

that file can be presented to a user without re-converting the file. Since actual stored

content is used, as modified by Putz, the claimed subject matter would be met. The

motivation would have been to increase efficiency, since a file can be directly accessed

and does not have to be re-converted, as taught by Putz (col. 5, ll. 25-35), and known to

one of ordinary skill in the art.

Guck and Putz as applied above teach a first file and second file, as described

above. Furthermore, Guck teaches operating on multimedia-related files (e.g., audio or

video, see fig. 8 and table 1). Guck and Putz do not expressly teach controlling an

encoding bit rate.

However, Astle teaches controlling an encoding bit rate for multimedia-related

files (e.g., col. 15, l. 24).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Guck and Putz, such that the encoding bit rate is

controlled as claimed. The motivation would have been to meet transmission bandwidth

limitations, as taught by Astle (col. 15, l. 24).

As to claim 10, Guck as applied above further teaches wherein the manipulating

step reproduces the predetermined content stored in either the first or second file (see

above).

As to claim 11, Guck as applied above further teaches wherein the selecting

step further selects the manipulating step in accordance with the format of either the

first or second file, whichever has been selected (see above, and fig. 2B).

As to claim 12, Guck as applied above further teaches wherein the manipulating

step transfers either the first or second file (see above).

As to claim 13, Guck as applied above further teaches wherein the selecting

step selects the manipulating step in accordance with a setting (see above).

As to claim 14, Guck as applied above further teaches a generating step for

generating the predetermined content in the second format on the basis of the first file

(see above).

As to claim 15, Guck as applied above further teaches a converting step for

converting either the first or second file into a third file for storing the predetermined

content in a third format (e.g., converting original shadow into a shadow containing

transformed output, also see above).

Claim 17 is drawn to substantially the same subject matter as claim 9, discussed

above.

As to claim 18, Guck as applied above teaches the following claimed subject

matter:

A storing unit configured to store a plurality of contents in a storage area of a

memory (fig. 1);

A database in which a first file ID identifying a first file of a predetermined content

stored in a first format and a second file ID identifying a second file of the predetermined

content stored in a second format may be associated with a content ID that identifies

the predetermined content (see above, and figs. 2, 7).

A content ID specifying unit configured to specify a content ID of the

predetermined content with the predetermined content is selected from a content list

(see above);

A selecting unit configured to select the first or second file based on the first or

second file ID from the database when the specified content ID is associated with the

first and second file ID (see above);

A manipulating unit configured to manipulate the first or second file, whichever

has been selected (see above).

The discussion above regarding "content stored in first/second formats" applies

to this claim. The discussion combines Guck with Putz.

Guck and Putz as applied above teach a first file and second file, as described

above. Furthermore, Guck teaches operating on multimedia-related files (e.g., audio or

video, see fig. 8 and table 1). Guck and Putz do not expressly teach controlling an

encoding bit rate.

However, Astle teaches controlling an encoding bit rate for multimedia-related

files (e.g., col. 15, l. 24).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Guck and Putz, such that the encoding bit rate is

controlled as claimed. The motivation would have been to meet transmission bandwidth

limitations, as taught by Astle (col. 15, l. 24).

As to claim 19, Guck as applied above further teaches a transmitting unit configured to transmit the predetermined content selected from the content list to other apparatus (see above, and fig. 1);

Wherein the selecting unit selects the first or second file according to the format supported by the other apparatus (see above, summary of the invention, an e.g., col. 8, ll. 10-12).

Claims 2-7 are drawn to substantially the same subject matter as claims 10-15, discussed above.

As to claims 8 and 16, Guck/Putz/Astle as applied above do not expressly teach wherein the manipulating unit or step deletes the first or second file.

However, Guck further teaches that as a database object, a virtual file can possess behavior used to process the file, such as deleting it. As such, Guck suggests that a file can be deleted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Guck/Putz/Astle, such that the first or second file is deleted. The motivation would have been to make more space available in the database for files that are no longer used, as known to one of ordinary skill in the art.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Lu whose telephone number is (571) 272-8594. The examiner can normally be reached on 8:30 - 5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached at (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Charles E Lu/
Examiner, Art Unit 2161
4/16/2009

/Etienne P LeRoux/
Primary Examiner, Art Unit 2161